



03500.015864

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

TAKASHI IKEDA

Application No.: 09/973,057

Filed: October 10, 2001

For: MAGNETORESISTIVE  
ELEMENT, AND MAGNETIC  
MEMORY USING THE SAME

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Examiner: VanThu Nguyen

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Group Art Unit: 2824

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August 21, 2002

Commissioner for Patents  
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In the Office Action dated July 22, 2002, the Examiner required restriction between Group I, claims 1-9, drawn to a magnetic thin film in class 365, subclass 171 and Group II, claims 10 and 11, drawn to a magnetic thin film in class 365, subclass 171. Although the films are classified in the same class and subclass, the Examiner argued that the separate groups are related as subcombinations usable together in a single combination. The Examiner argued Group I does not require a write line and bit line and, accordingly, has separate utility. The grounds of restriction are respectfully traversed.

Under M.P.E.P. §806.05(d) where two subcombinations are usable together in a single combination, the Examiner must show, by way of example, that one of the

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subcombinations has utility other than in the disclosed combination. It is said that the burden is on the Examiner to provide such an example.

The Examiner has argued that because the magnetic thin film of Group I does not require a write line and bit line, it has separate utility.

However, the separate utility must be in other or different relations. Under M.P.E.P. § 808.02, where, as disclosed in the application, the several inventions claimed are related, then when such related inventions are not patentably distinct as claimed, restriction is never proper. Where such related inventions, as claimed, are shown to be distinct, the Examiner must show by a separate classification, a separate status in the art, or a different field of search, that restriction is warranted.

Here, the claims of Groups I and II are directed to magnetic thin films, which are memory devices typically used in reproducing heads, MRAM, TMR or GMR, for example. Therefore, no separate utility is seen. Further, the films of Groups I and II are classified in the exact same class and subclass and have not been shown to have a separate status in the art. Only one search is required and, accordingly, there is no burden to the Examiner to examine all the claims in one application. Therefore, the restriction requirement should be withdrawn.

In any event, Applicants provisionally elect the claims of Group I, claims 1-9, with traverse.

